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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/761,915      | 01/17/2001  | Yasuo Tano           | 4084-2163           | 5564             |

21888 7590 08/12/2003

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EXAMINER

BUI, VY Q

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3731

DATE MAILED: 08/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

NK

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 09/761,915             |  | TANO ET AL.         |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | Vy Q. Bui              |  | 3731                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,7,9-15 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,9-15 and 21-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

Formal drawings filed and entered 03/10/2003 as paper #7 have been reviewed and approved.

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by "application number" and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The original "Oath and Declaration" does not state that: " All errors being corrected arose without deceptive intention". Further, the original "Oath and Declaration" was amended (1/17/2001) after the inventors had been signed the "Oath and Declaration" (10/22/2000)- see MPEP 60105.

A new and correct "Supplemental Oath and Declaration" must be filed stating that "all errors not covered by an "Oath and Declaration" arose without deceptive intention".

***Claim Rejections - 35 USC § 251***

Independent claims **1, 9, 12, 21, and new claim 26** and dependent claims **3-4, 7, 10-11, 13-15, 22-25 and new dependent claims 27-33** are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claim 1 (application 09/058,183) was amended to recite (I). **“a hollow tapered front tip”** and (II). **“grains are located in arrange of 0.5mm to 3.0mm from an en portion of said front tip”** to overcome the 102 (b) rejection entered on 12/04/1998 (application 09/058,183) as being anticipated by SHIMIZU (U. S. Pat. 3,809,101). In the argument filed 04/10/1998 (from line 13, page 5 to line 4, page 6 of **attached Amendment A/#6, dated April 10, 1998**), the applicants argued that SHIMIZU does

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not disclose the features (I) and (II) above, and therefore, amended claim 1 was clearly defined over SHIMIZU. The amendment and argument was presented to obviate the rejection and was convincing, therefore the amended claim 1 was allowed and issued in U.S. Pat. 5,921,998 (column 6, lines 8, and 11-12, U.S. Pat. 5,921,998). See MPEP 1412.02.

The omission of the features (I) and (II) above in the independent claims **1, 9, 12, 21 and 26** of the current application presents an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

### ***Response to Arguments***

Applicant's arguments and amendment entered as paper #9/B have been fully considered but they are not persuasive.

From the history of the prosecution of the parent case (application 09/058,183), the only independent claim 1 ('183) was allowed because the applicant's amendment to include features (I) and (II) in the claim (please see the arguments filed 04/10/1998, from line 13, page 5 to line 4, page 6 of previously attached Amendment A/#6, dated April 10, 1998 in the previous "Office Action"). In the arguments filed 04/10/1998 in the parent case, the applicants expressly relied on features (I) and (II) to define the instant invention over the prior art of rejection, i.e. SHIMUZU.

Because one of ordinary skill in the art does not expect to make SHIMUZU nail file having features (I) and (II), especially feature (II), which indicates abrasive grains in

a very short range (**grains are located in arrange of 0.5mm to 3.0mm from an end portion of said front tip**), therefore, feature (II) in claim 1 ('183) clearly defines the instant invention over SHIMUZY nail file.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



VQB  
8/8/2003.